

REMARKS

Applicants respectfully request entry of the foregoing amendments and reconsideration of the application in view of the amendments above and the remarks below. Claims 1-3, 5, and 6 have been amended, and claims 11-21 have been withdrawn from consideration by the Examiner's constructive election requirement in the final Office Action. Claims 1-21 remain pending in the application, of which claims 1 and 11 are independent.

In-person interview requested

Applicants hereby request that the Examiner grant their undersigned representative an in-person interview prior to the issuance of the next Office Action. Accordingly, Applicants respectfully request that the Examiner telephone the undersigned at 703-456-8108 to schedule an in-person interview at a time convenient to the Examiner prior to the mailing of the next Office Action.

Formal drawings submitted

The Office Action summary states that corrected drawings are required in reply to the outstanding final Office Action. In response, Applicants are filing formal drawings herewith, which incorporate the changes approved by the Examiner.

Claims 5-10 do not add new matter to the Specification

The Examiner has objected to the Amendment filed on November 12, 2002 under 35 U.S.C. § 132, alleging that it introduces new matter into the Specification. Applicants respectfully traverse this objection for the reasons set forth below.

Claim 5

The Examiner has objected to claim 5 as allegedly adding new matter to the Specification. Specifically, the Examiner asserts that the recitations of "organizing an inventory of hotel rooms as a plurality of attribute combinations" and "determining whether [a] room request can be met from ... inventory based on a number of rooms available for each identified attribute combination" somehow add new matter. Applicants respectfully disagree with the

Examiner's mischaracterization of these recitations as new matter, and submit that they are fully supported in the Specification, as originally filed.

For example, regarding the first recitation, beginning on page 28, the Specification discusses an attribute inventory system (AIS), which utilizes various attribute combinations. Additionally, Fig. 4 illustrates inventory organized according to attribute combinations. (*See* Specification at 30-31.)

Regarding the second recitation, the Specification specifically states that the "inventory 400 is tracked . . . to properly allocate inventory 400 among the guests. In the event that a guest requests features that are no longer available, the guests requests must be refused or otherwise accommodated ..." (Specification at 32.) The Specification also states that "[i]f AVAILABLE count is insufficient to honor the booking request, then the booking is denied." (Specification at 35-36.) This "AVAILABLE count" can be tracked for any attribute combination on any day, as discussed on page 36 of the Specification.

Thus, Applicants respectfully submit that claim 5 is fully supported by the Specification, as originally filed. Applicants submit that, in addition to the selections cited above, other selections may provide additional or alternate support for claim 5.

Claim 6

The Examiner has objected to claim 6 as allegedly adding new matter to the Specification. Specifically, the Examiner asserts that the recitation of "adjusting [a] number of rooms ... if [a] room request can be met from ... inventory" somehow adds new matter. Applicants respectfully disagree with this assertion, and submit that this recitation is fully supported in the Specification, as originally filed.

For example, among other selections, pages 35-36 of the Specification disclose calculating an "AVAILABLE count" (i.e., a number of rooms available), which is adjusted based on several criteria, including whether or not a request can be met from inventory (e.g., taking into account allocated or wait listed rooms).

Thus, Applicants respectfully submit that claim 6 is fully supported by the Specification, as originally filed. Applicants submit that, in addition to the selections cited above, other selections may provide additional or alternate support for claim 6.

Claim 7

The Examiner has objected to claim 7 as allegedly adding new matter to the Specification. Specifically, the Examiner asserts that the recitation of “denying [a] request” somehow adds new matter. Applicants respectfully disagree with this assertion, and submit that this recitation is fully supported in the Specification, as originally filed.

For example, the Specification discusses denying, or in other words refusing, a request, stating that if rooms with requested features “are no longer available, the guest’s requests must be refused.” (Specification at 32.)

Thus, Applicants respectfully submit that claim 7 is fully supported by the Specification, as originally filed. Applicants submit that, in addition to the selections cited above, other selections may provide additional or alternate support for claim 7.

Claim 8

The Examiner has objected to claim 8 as allegedly adding new matter to the Specification. Specifically, the Examiner asserts that the recitation of “[a] number of rooms available includ[ing] an allowed number of overbooked rooms” somehow adds new matter. Applicants respectfully disagree with this assertion, and submit that this recitation is fully supported in the Specification, as originally filed.

For example, the Specification clearly accounts for overbooked rooms in its determination of availability. Specifically, the “AVAILABLE count” is calculated using, among other counters, an “OVERBOOK” counter, which allows bookings over a “CONFIGURED count.” (Specification at 35-36.)

Thus, Applicants respectfully submit that claim 8 is fully supported by the Specification, as originally filed. Applicants submit that, in addition to the selections cited above, other selections may provide additional or alternate support for claim 8.

Claim 9

The Examiner has objected to claim 9 as allegedly adding new matter to the Specification. Specifically, the Examiner asserts that the recitation of “rooms available ... based

upon [a] forecast of demand” somehow adds new matter. Applicants respectfully disagree with this assertion, and submit that this recitation is fully supported in the Specification, as originally filed.

For example, the Specification discusses yield management systems (YMS), which can operate in concert with the attribute inventory system (AIS) to explore “what-if” scenarios. (Specification at 57-58.) Additionally, demand can be forecast using historical stay data. (See, e.g., Specification at 58.)

Thus, Applicants respectfully submit that claim 9 is fully supported by the Specification, as originally filed. Applicants submit that, in addition to the selections cited above, other selections may provide additional or alternate support for claim 9.

Claim 10

The Examiner has objected to claim 10 as allegedly adding new matter to the Specification. Specifically, the Examiner asserts that the recitation of “[a] first room rate [being] based on [a] number of rooms available” somehow adds new matter. Applicants respectfully disagree with this assertion, and submit that this recitation is fully supported in the Specification, as originally filed.

The Specification clearly discloses information about rates generally on pages 37-40. More specifically, page 40 of the Specification clearly discloses adjusting rates according to an adjustment procedure based on occupancy.

Thus, Applicants respectfully submit that claim 10 is fully supported by the Specification, as originally filed. Applicants submit that, in addition to the selections cited above, other selections may provide additional or alternate support for claim 10.

The objections to claim 5-10 should be withdrawn

Accordingly, for at least the reasons set forth above, Applicants respectfully request that the objection to claim 5-10 under 35 U.S.C. § 132 be withdrawn.

Claims 5-10 are supported by the Specification under 35 U.S.C. § 112, first paragraph

Claims 5-10 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse this rejection because, as specifically pointed out above regarding the objections to these claims under 35 U.S.C. § 132, each of these claims is fully supported in the Specification, as originally filed.

Accordingly, Applicants respectfully request that the rejection of claims 5-10 under 35 U.S.C. § 112 be withdrawn.

The restriction requirement is improper

The Examiner has indicated that she considers claims 11-21 to be directed to an invention independent or distinct from the invention of the originally filed claims. Specifically, the Examiner asserts that claims 1-10 (Group I) are directed to a first invention, and claims 11-21 (Group II) are directed to a second invention. Because an action on the merits had previously been mailed based on claims considered by the Examiner to be within Group I, the Examiner has required that the claims of Group I be constructively elected by original presentation.

To support the restriction requirement, the Examiner alleges that these two groups of claims are classifiable in independent subclasses, stating that Group I should be classified in class 705, subclass 6, and that Group II should be classified in class 705, subclass 28.

Applicants respectfully traverse the restriction requirement and the constructive election of claims 1-10, and reserve the right to appeal the restriction requirement and the election of Claims 1-10.¹ Applicants respectfully request that the Examiner consider claims 1-21 together on their merits because they are classifiable in the same subclass, and because it would not be a "serious burden" to do so.

Group I and Group II classifiable in same subclass

The claims of Group I and Group II could all be classified in class 705, subclass 5, which is generally directed to reservations, and should, therefore, be considered together. Applicants submit that subclass 5 is more appropriate for claims 1-10 than subclass 6, which is defined as

¹ Applicants note that claims 11-21 have been indicated as "withdrawn" in the claim amendments section of this paper for administrative convenience only.

“Coordination of *plural* reservations” such as “*plural trip segments*” and “*multiple distinct reservations for a single itinerary*.” Similarly, Applicants submit that subclass 5 is more appropriate for claims 11-21 than subclass 28, which is defined as “inventory management” for “establishing, maintaining, or updating a record of a *store of goods*.”

Therefore, as the claims of Group I and the claims of Group II could all be classified within the same subclass, Applicants respectfully submit that they should be examined together.

No serious burden to examine entire application

Regardless of whether or not the both groups of claims are classified within the same subclass, they do not present a “serious burden” to examine together and, therefore, should be examined together. Regarding when a restriction requirement is proper, the M.P.E.P. states:

If the search and examination of an entire application can be made without *serious burden*, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

MPEP § 803 (emphasis added).

The claims of Group I and the claims of Group II are directed to similar subject matter. For example, independent claim 1 is directed to “a method for determining a room rate for a guest,” which relates to reservations, such as at a hotel reservations, or the like. Similarly, independent claim 11 is directed to “a system for managing reservations.”

Thus, while the two groups identified by the Examiner could potentially be considered independent or distinct inventions, there would be no *serious burden* on the Examiner to examine all of the claims of both related groups on the merits.

Moreover, Applicants note that there are only 21 claims in the application, only two of which are independent. Applicants are allowed a total of 20 claims, three of which can be independent, without being required to pay additional claim fees. By imposing additional claim fees only for claims in excess of 20 (which limit Applicants exceed by merely one) and independent claims in excess of three (which limit Applicants do not even reach), it seems likely that, in most circumstances, the Commissioner expects that examination of numbers of claims approximately at or below these limits will generally not place a *serious burden* on the Examiner.

Therefore, because the burden on the Examiner, *if any*, would be minimal and would not rise to the level of a *serious burden*, Applicants respectfully submit that the Examiner must examine the entire application, including examination of claims 1-21 together, as stated in M.P.E.P. § 803.

Accordingly, Applicants respectfully request that the Examiner withdraw the restriction requirement, and examine all of the claims (1-21) that have been presented by Applicants on the merits.

Claims 1-3 are patentable under 35 U.S.C. § 103

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,732,398 to Tagawa (hereinafter "*Tagawa*") in view of a news release entitled, "Red Roof Inns Implements High-Tech Revenue Management System," dated June 2, 1998 (hereinafter the "*Red Roof release*"). Applicants respectfully traverse this rejection for the reasons set forth below.

Examiner's claim interpretation unreasonable

Applicants, in their prior response, argued that the Examiner failed to properly establish a *prima facie* case of obviousness, stating that the combination of cited references failed to teach or suggest "determining a first room rate for [a] first guest based on a comparison between guest information and historical information *associated with similar guests*," as recited in claim 1. (See Amendment filed November 12, 2002 at 11-12.)

In response, the Examiner argued that the term "*similar guests*" recited in claim 1 was somehow equivalent to *all* customers using the system disclosed in the *Red Roof release*. (See final Office Action at 12.) The Examiner states that the rationale for this overly broad reading is that customers "may be deemed similar merely because they are requesting hotel accommodations ..." (Final Office Action at 12.)

Applicants respectfully submit, however, that this interpretation of the words of claim 1 is unreasonable either as they are understood in light of the Specification, or according to their plain meaning.

M.P.E.P. § 2111.01 states that the Examiner is required to interpret words of a claim in view of any definitions provided in the Specification, or (absent such definitions) in view of their plain meanings:

When not defined by applicant in the specification, the words of a claim *must* be given their plain meaning. In other words, they must be read as they would by those of ordinary skill in the art.

M.P.E.P § 2111.01 at 2100-48 (emphasis added).

The Examiner has adopted an interpretation of claim 1 that is wholly unfounded in view of either the Specification or the plain meaning of the words of the claim. Therefore, the Examiner's interpretation is unreasonable.

The Specification discusses tracking attributes of guests that could be used to determine similarity between guests in several locations in the Specification. For example, the reservations management system (RMS) 10 can access multiple RMS Databases 350, one of which is a customer profile database 320. (See Specification at 9 *et seq.*, Figure 3). Beginning on page 59, the Specification discusses guest history and profile information in detail. Among other types of information stored in a guest profile, are the following types of information: market segment, point of origin, negotiated rate, rate(s) actually accepted, historical spending, requested attributes, mandatory attributes, preferred attributes/features, rate resistance, and statistical tendencies. (Specification at 59.)

Therefore, according to the Specification, it seems clear that more information than the mere fact that guests are requesting hotel accommodations (*e.g.*, one or more of the types of information in the guest profile or stored in the customer profile database 320) would be required to determine if the guests are similar. Hence, the Examiner's interpretation of the meaning of the words "similar guests" is unreasonable in view of the Specification.

Moreover, One skilled in the art would not assume that the claimed "*similar* guests" includes *all* guests, because such a reading would effectively eliminate these words from the claim. That is, if *all* guests using the claimed system were considered "similar," there would be no reason to specify that the type of historical information to be used in a comparison should be associated with *similar* guests. Further, if all guests were considered similar, there would be no

reason to make a comparison at all, as the comparison would be the same for each guest (*i.e.*, each guest would be compared against all guests). Of course, eliminating words from a claim is directly contrary to the requirement of giving the term its plain meaning.

Therefore, the Examiner's interpretation of the meaning of the words "similar guests" is unreasonable in view of the plain meaning of those words, and is beyond what one of ordinary skill in the art would consider the "broadest reasonable interpretation" of the claim.

Standard under 35 U.S.C. § 103

According to M.P.E.P. § 2142, three criteria must be met to establish a *prima facie* case of obviousness. These criteria are: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) *the prior art references must teach or suggest all the claim limitations*.

It is well established that "there must be some reason for the combination other than the hindsight gleaned from the invention itself." Uniroyal v. Rudkin-Wiley, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). Moreover, there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the primary reference in the manner suggested by the Examiner. In re Laskowski, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989). The court has also stated that "obvious to try" is not the standard under 35 U.S.C. § 103. In re Fine, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

Additionally, as pointed out by the court in In re Fritch, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Fritch, at 1783-1784.

Accordingly, for at least the same reasons discussed above with respect to either independent claim 1 or claim 5, Applicants respectfully request that the rejection of claim 8 be withdrawn.

Conclusion

All rejections having been addressed, Applicants respectfully submit that the present application is in condition for allowance, and earnestly solicits a Notice of Allowance, which is believed to be in order. Should the Examiner have any questions regarding this communication, or the application in general, she is invited to telephone the undersigned at 703-456-8108.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

Dated: _____

May 4, 2004

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Prima facie case of obviousness not properly established

Applicants respectfully submit that the Examiner has not properly established a *prima facie* case of obviousness under 35 U.S.C. § 103. Specifically, Applicants respectfully submit that the prior art references applied by the Examiner, even when considered in the combination proposed in the office action, fail to teach or suggest all of the features of claim 1.

For example, the references cited by the Examiner fail to teach or suggest, among other features, “determining a first room rate for [a] first guest based on a comparison between guest information and historical information *associated with similar guests*,” as recited in independent claim 1.

The Examiner has admitted this fact multiple times. In the first Office Action dated July 9, 2002, the Examiner states, “*Tagawa* does not specifically teach that [a] room rate is based on a comparison between guest information and historical information associated with [with] similar guests” (First Office Action at 4.) On that same page, the Examiner admits that the *Red Roof release* “does not specifically teach that the historical data used in the analysis is data associated with similar guests.” (First Office Action at 4.) Similarly, in the final Office Action, the Examiner repeated the shortcoming of the *Red Roof release* stating that it “does not expressly disclose that the current and historical data used in the analysis is data associated with similar guests.” (Final Office Action at 11)

Therefore, because the references of record do not teach or suggest this feature the Examiner has not met her burden in establishing a *prima facie* case of obviousness as the third criteria set forth in M.P.E.P. § 2142 has not been satisfied.

Additionally, Applicants note that, even if the Examiner feels that a feature is abundantly obvious, unless a prior art reference teaches that feature, the Examiner cannot properly establish a *prima facie* case of obviousness. As pointed out in In re Fine, whether or not it might be “obvious to try” a claim feature missing from the prior art is irrelevant; however, this erroneous standard appears to be the standard that the Examiner is applying to independent claim 1. Moreover, as pointed out in In re Fritch, regardless of whether the references of record *could* possibly be modified in the manner suggested by the Examiner, that does not mean the modification is obvious.

The rejection of claims 1-3 under 35 U.S.C. § 103 should be withdrawn

Accordingly, for at least the reasons discussed above, Applicants respectfully request that the rejection of Claim 1 under 35 U.S.C. § 103 be withdrawn. Additionally, for at least the same reasons, Applicants respectfully request that the rejection of Claims 2-3, which depend therefrom, also be withdrawn.

Claims 5-7 and 9-10 are patentable under 35 U.S.C. § 103

Claims 5-7 and 9-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tagawa* in view of the *Red Roof release*, and further in view of U.S. Patent No. 5,404,291 to Kerr et al. (hereinafter "*Kerr*"). Applicants respectfully traverse this rejection for the reasons set forth below.

Kerr is directed to an inventory control process for reservation systems for hotel chains. In rejecting Claims 5-7 and 9-10, the Examiner has cited *Kerr* as allegedly teaching a determination of whether a number of rooms are available for a particular attribute combination. *Kerr* does not, however, remedy the deficiencies of the combination of *Tagawa* and the *Red Roof release*, discussed above.

Accordingly, for at least the same reasons as those discussed above in connection with independent claim 1, Applicants respectfully request that the rejection of claims 5-7 and 9-10, which depend therefrom, be withdrawn.

Claim 8 is patentable under 35 U.S.C. § 103

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Tagawa*, the *Red Roof release*, and *Kerr*, and further in view of U.S. Patent No. 4,775,936 to Jung (hereinafter "*Jung*"). Applicants respectfully traverse this rejection for the reasons set forth below.

Jung is directed to an overbooking system for overbooking scarce resources such as seats on a vehicle or aircraft. In rejecting claim 8, the Examiner has cited *Jung* as disclosing including an allowed number of overbooked rooms among a number of rooms available. *Jung* fails, however, to overcome the deficiencies of the combination of references used to reject either dependent claim 5 or independent claim 1, from which claim 8 depends, as discussed above.